

### ***Remarks***

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 74-135 are pending in the application, with claims 74, 75, 76, 122 and 135 being the independent claims. Claims 41-73 are cancelled without prejudice to or disclaimer of the subject matter therein in favor of claims 74-135 for clarity.

Support for claims 74-135 can be found throughout the specification. For example, support for claim 74 can be found, *inter alia*, in Figures 1 and 2 and page 6, lines 4-8. Support for claim 75 can be found, *inter alia*, at page 6, lines 4-10. Support for claims 76, 77, 79 and 80 can be found, *inter alia*, at Figure 1, at page 12, lines 13-14; and at page 6, lines 21-34, which states that all eight cysteines and the signature motif for the PDGF/VEGF family is conserved in VEGF3 and calls attention to Figure 2. From looking at Figure 2, one of ordinary skill in the art would appreciate that amino acids 69 to 82 of SEQ ID NO:2 contain the signature motif, that this signature motif is encoded by nucleotides 205 to 246 of SEQ ID NO:1, and that the portion of VEGF3 that contains the conserved cysteines and motif includes amino acids 46 to 123 of SEQ ID NO:2. Support for claims 78 and 81 can be found, *inter alia*, in Example 3. If the procedures outlined in Example 3 are followed, a polypeptide consisting of amino acids 30 to 221 of SEQ ID NO:2 would be produced.

Support for claims 82-91 and 127-128 can be found, *inter alia*, at page 7, lines 21-24 and page 8, lines 16-26. Support for claims 92-116 and 129-133 can be found, *inter alia*, at page 12, line 32 to page 18, line 21. Support for claims 117-121 and 134 can be found, *inter alia*, at page 11, line 32 to page 12, line 2 and page 24, line 4 to page 25, line 4. Support for claims 122-126



can be found, *inter alia*, at page 12, lines 13-14, page 10, lines 28-33 and page 29, line 27 to page 30, line 5. Support for claim 135 can be found, *inter alia*, at page 6, lines 21-34 and at page 12, lines 13-14. These changes are believed to introduce no new matter, and their entry is respectfully requested.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

***Rejections under 35 U.S.C. § 112***

The Examiner rejected claims 57, 63, and 69 under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement, for reciting RNA. Applicants have cancelled claims 57, 63 and 69 in favor of claims 74-135 for clarity. As new claims 74-135 do not recite RNA, the rejection is now moot. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner rejected claim 73 under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement for reciting a method of making a polypeptide by expressing polynucleotides with 95% identity to other polynucleotides. Applicants have cancelled claim 73 in favor of new claims 74-135 for clarity. As new claims 74-135 do not recite methods of making polypeptides by expressing polynucleotides with 95% identity to reference polynucleotides, the rejection is now moot. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner rejected claims 41-73 under 35 U.S.C. § 112, second paragraph, for allegedly being indefinite. Applicants have cancelled claims 41-73 in favor of new claims 74-135 for clarity.

The Examiner states that in claim 41, "the use of % identity is indefinite without a recitation of an algorithm for calculating this identity." (Paper No. 20, page 5, section 6). The



Examiner further states that "[c]laim 41 is also indefinite for the recitation 'comprising a polynucleotide at least 95% identical to a member' because it is not clear what property is intended to be 95% identical." (Paper No. 20, page 6, section 8). Applicants have cancelled claim 41 in favor of claims 74-135 for clarity. As new claims 74-135 do not recite percent identity, the rejection is moot. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner alleges that claims 41, 50 and 51 are indefinite for the recitation of polynucleotides which hybridize under stringent conditions to reference polynucleotides. Applicants have cancelled claims 41, 50 and 51 in favor of claims 74-135 for clarity. As claims 74-135 do not recite polynucleotides which hybridize to reference polynucleotides, this rejection is now moot. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner further states that "[c]laim 50 is also indefinite because of the recitation of 'having a nucleotide sequence identical to a nucleotide sequence in (a), (b), (c), or (d).'" (Paper No. 20, page 7, section 9). Applicants have cancelled claim 50 in favor of claims 74-135 for clarity. None of the added claims contain the recitation objected to by the Examiner. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner also alleges that claim 73 is indefinite for lacking antecedent basis for the limitation of "the polypeptide." Applicants have cancelled claim 73 in favor of claims 74-135 for clarity. None of the added claims lack antecedent basis for this recitation. Accordingly, withdrawal of this rejection is respectfully requested.

### ***Rejections under 35 U.S.C. § 102***

The Examiner rejected claims 51, 52, 54-56, 58, 60-62, 64 and 66-68 under 35 U.S.C. § 102(b) as allegedly being anticipated by Gonzalez *et al.*, *Proc. Natl. Acad. Sci. USA*



82:7666-7670 (1985). Applicants have cancelled claims 51, 52, 54-56, 58, 60-62, 64 and 66-68 in favor of new claims 74-135 for clarity. Applicants respectfully traverse this rejection as it applies to new claims 74-135.

The Examiner states that "Gonzalez *et al.* disclose an isolated polynucleotide which comprises at least 30 contiguous nucleotides of SEQ ID NO:1 of the instant application" because "[n]ucleotides 3923 to 3958 of Gonzalez *et al.* are identical to nucleotides 7 to 42 of SEQ ID NO:1." The Examiner also states that Gonzales discloses DNA that would hybridize under stringent conditions to the polynucleotide of SEQ ID NO:1. None of the added claims recite an isolated nucleic acid molecule of any 30 contiguous nucleotides of SEQ ID NO:1 or recite hybridization conditions. Therefore, Gonzalez does not anticipate the pending claims. Accordingly, withdrawal of this rejection is respectfully requested.

The Examiner rejected claims 51-56, 58-62 and 64-68 under 35 U.S.C. § 102(e) as allegedly being anticipated by Eriksson *et al.*, U.S. Patent No. 5,607,918. Applicants have cancelled claims 51-56, 58-62 and 64-68 in favor of claims 74-135 for clarity. Applicants respectfully traverse this rejection as it applies to claims 74-135.

Applicants would like to point out that Eriksson was filed on June 6, 1995, the same day as the present application. Therefore, the entire content of Eriksson does not qualify as 35 U.S.C. § 102(e) prior art against the present claims. *See* M.P.E.P § 2136.03; and *Ex parte Gilderdale*, 1990 Pat. App. LEXIS 25 (Bd. Pat. App. & Inter. Appeal No. 89-0352). However, Eriksson does claim priority to U.S. Application No. 08/397,651, filed March 1, 1995. Therefore, the only subject matter that *may* qualify as prior art against the present claims is that which is contained in U.S. Application No. 08/397,651. A copy of this priority document is enclosed for the Examiner's convenience.



The Examiner directs attention to SEQ ID NO:10 and Figure 10 of Eriksson as being related to the polynucleotides of the present invention. Eriksson's priority application, U.S. Appl. No. 08/937,651, does not contain this sequence. Therefore, the Examiner has not established a *prima facie* case of obviousness. Accordingly, withdrawal of this rejection is respectfully requested.

***Rejections under 35 U.S.C. § 103***

The Examiner rejected claims 57, 63 and 69 under 35 U.S.C. § 103(a) as allegedly being obvious over Gonzalez or Eriksson. Applicants have cancelled claims 57, 63 and 69 in favor of claims 74-135 for clarity. As stated above, the entire disclosure of Eriksson is not available as prior art against the present claims. It is the Examiner's position that the art renders claims to RNA obvious. The present claims do not require the isolated nucleic acid molecule to be RNA. Therefore, this rejection is now moot. Accordingly, withdrawal of this rejection is respectfully requested.

***Other Matters***

The Examiner cites two additional documents, Sylvester *et al.*, *Gene* 84:193-186 (1989) and Kern *et al.*, *Science* 252:1708-1711 (1991). The Examiner states that both of these documents teach DNA comprising at least 30 contiguous nucleotides of SEQ ID NO:1. Although the Examiner did not make a rejection based on these documents, Applicants would like to point out that the present claims do not recite DNA comprising any 30 contiguous nucleotides of SEQ ID NO:1.



### *Conclusion*

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

*Andrea Jo Kamage*

Andrea Jo Kamage  
Agent for Applicants  
Registration No. P-43,703

Date: November 23, 1998

1100 New York Avenue, N.W.  
Suite 600  
Washington, D.C. 20005-3934  
(202) 371-2600